

REMARKS

The comments of the Examiner as set forth in the office action have been carefully studied and reviewed.

In this response, claims 1-14, 20-53 and 56-63 have been canceled, claims 54 and 55 have been amended, and new claims 64-72 have been added. For the reasons set forth below, it is respectfully urged that the present application is in condition for allowance, and allowance is respectfully requested.

First, the Patent Office has rejected claims 15-19, 54 and 55 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 5,832,449 (the '449 patent) and Deaton et al., U.S. Patent No. 5,644,723.

Respectfully, the claims presented herein are not obvious in view of the claims in the '449 patent and Deaton.

In setting forth the obviousness-type double patenting rejection, the Patent Office implies that the claims in the '449 reference teach varying the value of the media. That is not the case. Claim 1, for example, relates to a method of managing pharmaceutical trial products, and in the claim there is the element of forming a series of product trial cards that are utilized in dispensing and managing pharmaceutical trial or sample products. However, none of the claims of the '449 patent teach or suggest that the product trial cards vary in value. They have only one value. They permit the holder, in certain situations, to obtain a sample pharmaceutical product from a pharmacy. The product trial card does not vary in value from time to time.

The Patent Office takes the position that Applicants' claimed invention is obvious in view of the '449 claims and Deaton. In particular the Patent Office states:

It would have been obvious to one of ordinary skill in the art to combine U.S. 5,832,449 and Deaton. The motivation would have been to issue incentive coupons based upon said activation signal, (Deaton, abstract).

Office Action, p. 3.

First, the proffered motivation is cryptic and conclusionary. Furthermore, the proffered motivation is not understood. The claims of the present application call for the issued medium to have a variable value according to selected conditions. This means, of course, that the issued medium has one value at one time, and then upon the occurrence of a selected condition, has another value which is different from the first value. Hence, the motivation for combining Deaton with the '449 patent is not understood. Indeed, the Patent Office has not set forth what elements in Deaton would be used and how those elements in Deaton would be used to modify the '449 claims or '449 disclosure. Thus, not only is the proffered motivation conclusionary, but the Patent Office has failed to specifically point out the factual basis for the obviousness rejection.

In any event, the '449 claims are directed to a method of managing a pharmaceutical product trial program. It is specific to pharmaceutical trial products. The objective behind the '449 claims is to dispense pharmaceutical trial or sample products to patients by utilizing doctors and pharmacists, and at the same time being able to record and manage the flow of pharmaceutical trial products to patients. There is no reason to provide any special incentive to patients. The pharmaceutical trial products are free in any event. If the pharmaceutical trial products are free, then it does not logically follow that there would be any incentive to vary the value associated with the product trial cards. Again, the idea is to give away the pharmaceutical trial products, but via a system that will manage the pharmaceutical trial program for a pharmaceutical business.

In addition, the Examiner has rejected claims 15-19, 54 and 55 under Section 102(e) as being anticipated by Deaton et al. Respectfully, Deaton et al. does not anticipate any of the claims in this case. In order to anticipate, it follows that all of the elements of each claim, as properly construed, must be fully met by Deaton.

Claim 15 includes the element of "identifying each medium with an identifier and recording the identifier in a database such that the at least one good or service associated with

the medium can be determined.” Deaton does not teach or show this element. The Examiner refers to Deaton, col. 4, ll. 44-47 as evidence that this element is taught. However, a reading of this section of Deaton indicates that what is actually recorded in a database is a customer’s financial instrument account number, such as for example, a check number, a credit card number, etc. This is a vehicle or system that enables the seller to determine the credit risk of a customer. This has nothing whatsoever to do with providing the coupons in the case of Deaton with an identifier which associates at least one good or service with a particular coupon. In Deaton the coupon does not include an identifier and recording that identifier in a database. Again, the customer’s check number or credit card number is recorded in the database for credit risk purposes.

Claim 15 also calls for assigning an inactive status to the media such that while assuming the inactive status, the goods or services associated with the media may not be redeemed. Deaton does not teach this. The coupon in the Deaton disclosure never assumes an inactive status. The Examiner points to Figure 6A and col. 31, ll. 60-66 of Deaton. However, this does not say anything about the status of the coupons in Deaton. This is about assigning a status to the customer’s record. For example, Deaton provides as follows:

The type of customer information transferred by the global update function is based on store management policies. The recommended approach to exchanging global customer information is as follows:

- (a) Negative Status Records - All NEGATIVE status records (NEGATIVE or CASH ONLY status) accessed (created or updated) since the last transfer; and
- (b) Customer Records - All customer records with status values CAUTION, NEGATIVE, CASH ONLY and STOLEN accessed (created or updated) since the last file transfer;
- (c) POSITIVE status records (even those designated MANAGER ONLY) are not recommended for global transfer.

As a result, the local customer database contains negative status records (including NEGATIVE and CASH ONLY status and BAD Frequency/\$Amount) for all store locations (although each remote system only transfers to the host the negative status records for its locations).

Deaton et al., col. 31, ll. 7-26.

This simply indicates the credit risk of the customer, and has nothing to do with the coupons being active or inactive.

In addition, claim 15 calls for activating at least some of the media by changing the status of the media from an inactive state to an active state and recording the change of the status in the database. The Examiner points to Deaton, Figure 6A, col. 5, ll. 9-24 and col. 31, ll. 60-66. Again, this disclosure relates only to customer credit information. Based on past history, Deaton is able to determine if a customer is a good credit risk, or a poor credit risk, and information is recorded and referred to relating to this past credit history. There is nothing in Deaton about activating and deactivating the status of the coupons being discussed.

Claim 66 is similar to claim 15, but expresses the varying value concept in a different way. In particular, claim 66 recites the element: "varying the value of each medium such that the value of the medium varies according to selected conditions." As discussed in Applicants' application, the value of each medium can vary over a period of time depending on selected conditions or circumstances. That is not what is taught in Deaton. The individual coupons in Deaton never vary in value. It is true that Deaton ran a test where each of a series of coupons had a different value. This test was conducted to determine what would motivate a consumer to use a particular coupon. Here, each of Deaton's coupons have only one value. In the case of Applicants' claimed invention, each medium has a variable value.

In this case, it is difficult to determine how the Patent Office has construed elements and limitations of the claims. However, it is clear that the elements discussed above have been misconstrued, and given interpretations that are unreasonable, inconsistent with ordinary meanings, and contrary to how a person of ordinary skill in the art would construe them in the context of the present application. In the event that this response does not place the present application in condition for allowance, the Examiner is respectfully requested to provide an

explicit construction for the elements of claim 15 and 22 relating to identifying each medium with an identifier, assigning an inactive status to the media, activating at least some of the media, and varying value of each of the mediums.

For the foregoing reasons, it is respectfully urged that the present application is in condition for allowance and allowance is respectfully requested.

Respectfully submitted,

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